

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY S. MARCZAK
and RICK A. MINNER

Appeal No. 2005-2573
Application 09/899,591

ON BRIEF

Before WARREN, OWENS and JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, and based on our review, find that we cannot sustain the grounds of rejections advanced on appeal: appealed claims 1, 3, 4, 6 through 10, 13 through 17, 20, 22, 23, 26 through 28 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Arrowsmith et al. (Arrowsmith '752) in view of the publication to Arrowsmith et al. (Arrowsmith), and in further view of Shepard, Beckett et al. (Beckett), Schneeberger et al. (Schneeberger) and Mosier (final action mailed September 3, 2004 (hereinafter final action), pages 6-9);¹ appealed claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Arrowsmith '752 in view of Arrowsmith, Shepard, Beckett, Schneeberger and

¹ The examiner states in the answer (page 2) that the grounds of rejection are set forth in the final action.

Mosier as applied above, and further in view of Berdan et al. (final action, pages 9-10); and appealed claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Arrowsmith '752 in view of Arrowsmith, Shepard, Beckett, Schneeberger and Mosier as applied above, and further in view of Frantzen et al. (final action, page 10).²

We refer to the answer and to the brief and reply brief for a complete exposition of the positions advanced by the examiner and appellants.

The dispositive issue in this appeal is whether one of ordinary skill in this art would have found in the combined teachings of the applied prior art, particularly the combined teachings of Arrowsmith '752, Arrowsmith, Schneeberger and Mosier, teachings and inferences which would have led this person to seal the hard anodic layer produced by hard anodizing of aluminum taught by Arrowsmith '752 (e.g., col. 1, l. 59, to col. 2, l. 15, col. 2, l. 55, to col. 3, l. 35, col. 3, ll. 52-57, and col. 4, ll. 15-51) and Arrowsmith (e.g., page 68, "anodizing and post-anodizing treatment") with the sealing methods taught in Schneeberger (e.g., col. 1, ll. 33-54, col. 2, ll. 16-41; and col. 3, ll. 17-35) and Mosier (e.g., col. 3, ll. 22-27, col. 5, ll. 31-40, and col. 5, l. 66, to col. 6, l. 13) for half-hard anodic layers produced by the processes disclosed in these references.³

Appellants contends that the hard anodizing step used by Arrowsmith '752 produces "an anodic layer which is environmentally stable and unaffected by the presence of water," and the anodizing step is followed by an etching step, and that Arrowsmith also teaches that hard anodizing is followed by an etching step; and that Schneeberger "discloses sealing an anodic layer of an environmentally unstable soft-anodizing aluminum part (which is naturally porous) to protect against corrosion" and "seals a very specific type of anodic layer – a soft-anodic layer which is known to be environmentally unstable and prone to corrosion" (brief, pages 6-9; original emphasis deleted). Appellants submit that "there is no reason to seal the hard anodized

² Appealed claims 1, 3, 4, 6 through 10, 13 through 17, 20, 22, 23, 26 through 28 and 30 through 32 are all of the claims in the application. See the appendix to the brief.

³ It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, *see In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

aluminum of Arrowsmith[‘752] because the anodic layer of that aluminum . . . is superior to previous anodizing techniques (such as that in Schneeberger), and is immediately environmentally stable after hard anodizing,” and that the thick anodic layer of Arrowsmith ‘752 is “not known to requires a sealing layer to protect against corrosion and hydration (brief, pages 9-10; original emphasis deleted).

The examiner acknowledges that “the anodized surfaces of Arrowsmith are corrosion resistant” and finds that “so are the anodized surfaces of Schneeberger,” citing col. 1, ll. 11-16, pointing out that “[t]he primary purpose of the sealant in Schneeberger is to provide improvement in corrosion resistance and to trap colorant in the pores” (answer, page 3; original emphasis deleted). The examiner contends that that “there is no evidentiary support” for appellants’ suggestion “that the anodized layer of Schneeberger is a different ‘soft’ anodized aluminum,” finding that “[i]n fact, both anodic layers are formed in sulfuric acid . . . to the same thickness (20 μ m) under very similar conditions (time, temperature and current density). See the Arrowsmith publication section entitled ‘Experimental Procedure’ and Schneeberger (Col. 3, Lines 17-30)” (answer, page 3).

Appellants reply that the teachings in “Arrowsmith provides that the anodic layer alone is a complete product that needs no further process; it is completely stable by itself – not merely ‘resistant’ to corrosion,” pointing out that “Schneeberger clearly states that its anodic later improves corrosion resistance, . . . does ‘not offer sufficient corrosion protection’ and that the anodic layer ‘has to be sealed’ . . . [and] is unstable,” requiring additional processing to become environmentally stable” (reply brief, pages 1-2). Appellants further contend that the anodizing conditions of Arrowsmith and Schneeberger are dissimilar, presenting a table showing differences in temperature, time and current density based on “Arrowsmith ‘Experimental Procedure’ and Schneeberger, Col. 3, Lns. 17-30” (reply brief, page 2). On this basis, appellants submit that “there is no motivation to attempt to modify the already complete and stable Arrowsmith anodic layer with the sealing process of Schneeberger, which is designed specifically for different, inferior anodic layers” (*id.*).

On this record, we agree with appellants’ position supported by the disclosures of the Arrowsmith references and Schneeberger. We further find that the anodizing conditions taught

by Mosier for “[a] typical anodizing procedure” at col. 5, ll. 31-37, are closely aligned with the half-hard anodizing process of Schneeberger. Thus, because we determine that one of ordinary skill in this art would not have been motivated to seal the hard anodic surface of the Arrowsmith references, we have no basis to consider whether one of ordinary skill in the art would have a reasonable expectation of success in doing so. *See Brown & Williamson Tobacco Corp. v. Phillip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000), citing *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

Accordingly, on this record, we find that the examiner has not established a *prima facie* case of obviousness based on the claimed invention encompassed by the appealed claims, including all of the limitations thereof arranged as required therein, and therefore, we reverse the grounds of rejection advanced on appeal.

The examiner’s decision is reversed.

Reversed

Charles Warren
CHARLES WARREN

CHARLES F. WARREN
Administrative Patent Judge

Terry J. Owens

TERRY J. OWENS
Administrative Patent Judge

Henry E. Jones

JEFFREY T. SMITH
Administrative Patent Judge

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